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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IKON Office Solutions West, Inc.,

Petitioner,

v.

Integrity Office Solutions, L.L.C.,

Registrant.



01-28-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Cancellation No.

PETITION TO CANCEL

In the matter of Registration No. 2,454,883 for the service mark "IOS" ("Registrant's Mark"), registered May 29, 2001 on the Principal Register, for "providing a single source turnkey outsourcing solution for companies that are upgrading, expanding or moving in the nature of procurement services, namely, purchasing or leasing office equipment and furniture for others," in International Class 35; "providing single source turnkey outsourcing solution for companies that are upgrading, expanding or moving, by providing lease financing," in International Class 36; "providing a single source turnkey outsourcing solution for companies that are upgrading, expanding or moving in the nature of installing of office furniture and flooring, and planning, laying out and constructing of commercial office space for others," in International Class 37; and "providing a single source turnkey outsourcing and solution for companies, namely, designing for others an integrated package of office equipment, furniture and office layout planning, including comprehensive project management and technology design and transfer, for use in assisting businesses to upgrade, expand and relocate," in International

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IKON Office Solutions West, Inc. ("Petitioner"), a Delaware corporation, having a place of business at 1210 SW Garden Place, Portland, Oregon, 97223, believes that it will be damaged if such registration is permitted to subsist on the Principal Register and, therefore, hereby gives notice of its intention to petition to cancel the registration of said service mark.

The grounds for the petition to cancel are as follows:

1. Petitioner is the owner of the service mark "IOS CAPITAL" ("Petitioner's Mark"), for financing services ("Petitioner's services"). Petitioner has used the service mark "IOS CAPITAL" in commerce since at least as early as February 22, 1998.

2. Since at least February 22, 1998, Petitioner has continually used and promoted the "IOS CAPITAL" service mark.

3. By virtue of the continuous sale and promotion of Petitioner's services under Petitioner's Mark, and by virtue of maintenance of its high quality and standards relating thereto, consumers and others have come to recognize Petitioner's "IOS CAPITAL" mark as an indication of origin and, as a consequence, Petitioner has established valuable goodwill and exclusive rights in the "IOS CAPITAL" mark.

4. As reflected in the records of the Patent and Trademark Office (PTO), on July 18, 2001, Petitioner applied for registration of its "IOS CAPITAL" mark on the Principal Register of the PTO. Petitioner's application has been assigned Serial No. 76/287,234. A computer generated copy of Serial No. 76/287,234 printed from the PTO's TARR internet database pages at <http://tarr.uspto.gov/> is attached hereto as Exhibit A.

5. As reflected in the records of the PTO, Registrant is the owner of the service mark "IOS", Registration No. 2,454,883, registered May 29, 2001 on the Principal Register, for "providing a single source turnkey outsourcing solution for companies that are upgrading, expanding or moving in the nature of procurement services, namely, purchasing or leasing office equipment and furniture for others" in International Class 35; "providing a single source turnkey outsourcing solution for companies that are upgrading, expanding or moving, by providing lease financing" in International Class 36; "providing a single source turnkey outsourcing solution for companies that are upgrading, expanding or moving in the nature of installing of office furniture and flooring, and planning, laying out and constructing of commercial office space for others" in International Class 37; and, "providing a single source turnkey outsourcing solution for companies, namely, designing for others an integrated package of office equipment, furniture and office layout planning, including comprehensive project management and technology design and transfer, for use in assisting businesses to upgrade, expand and relocate" in International Class 42, referred to collectively herein as "Registrant's services". A computer generated copy of Registration No. 2,454,883 printed from the PTO's TARR internet database pages at <http://tarr.uspto.gov/> is attached hereto as Exhibit B.

6. As shown in Exhibit B, Registrant's earliest claimed date of first use of Registrant's Mark is May, 1999, subsequent to Petitioner's first use of Petitioner's Mark, which occurred at least as early as February 22, 1998.

7. In connection with Petitioner's Application Serial No. 76/287,234 for "IOS CAPITAL," an Office action was issued on September 5, 2001, in which Petitioner's Mark was refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on Registrant's Registration No. 2,454,883 for "IOS".

8. Registrant's "IOS" mark is virtually identical to Petitioner's previously used "IOS CAPITAL" mark, as both Petitioner's Mark and Registrant's Mark contain the identical dominant portion "IOS".

9. Due to the identity of the dominant portion of Petitioner's Mark and Registrant's Mark, confusion as to the source of Petitioner's and Registrant's services is likely.

10. Customers of Petitioner as well as others familiar with Petitioner's "IOS CAPITAL" mark, upon encountering Registrant's services offered in connection with a highly similar mark, would be likely to believe and would be justified in so believing, that such services originated from Petitioner, or were offered in association or affiliation with, or under authorization of Petitioner. Thus, Registrant's Mark, as used for its services, would lead persons familiar with Petitioner's Mark and services to believe that Registrant's services are rendered by or offered in affiliation with or under license from Petitioner.

11. Additionally, Registrant's Mark, by reason of its near identity to Petitioner's Mark, will be able to gain or maintain a foothold in Petitioner's market or closely-related markets, by exploiting not only the conscious, but also the subliminal or subconscious association with Petitioner's Mark. Customers of Registrant's services will thus identify the properties and reputation of Registrant's services with those of Petitioner.

12. Petitioner has no control over the quality of services offered by Registrant in connection with Registrant's Mark.

13. The registration of Registrant's Mark on the Principal Register is inconsistent with Petitioner's rights under the common law and the Trademark Act, 15 U.S.C. § 1051 *et seq.*, and is and will continue to be damaging to Petitioner. Registrant's registration and use of "IOS" not only promotes confusion in the marketplace, but is also inimical to the goodwill and reputation associated with Petitioner's Mark.

14. For the reasons stated above, Petitioner believes that if Registrant is permitted to maintain its registration for the mark "IOS", confusion of the trade and public, resulting in damage and injury to Petitioner, would be caused or would result by reason of the identity of the dominant portions of Registrant's Mark and Petitioner's Mark.

15. If Registrant is permitted to maintain Registration No. 2,454,883 for the services identified, it would retain there-by at least a *prima facie* exclusive right to use the "IOS" mark. Such registration would continue to be a source of damage and injury to Petitioner and to Petitioner's customers.

16. For the reasons stated above, Petitioner believes that if Registrant is permitted to maintain its Registration 2,454,883 on the Principal Register, Petitioner will be harmed by reason of the citation of Registrant's Registration No. 2,454,883 as a bar to registration of Petitioner's "IOS CAPITAL" mark.

17. As a consequence of the status of Registration No. 2,454,883 as a bar to registration of Petitioner's "IOS CAPITAL" mark, said Registration No. 2,454,883 is a source of damage and injury to petitioner.

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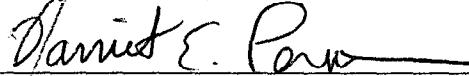
WHEREFORE, Petitioner prays that Registration No. 2,454,883 be canceled and that this cancellation action be sustained.

A duplicate copy of this Petition to Cancel is enclosed herewith.

A check in the amount of \$1,200.00 is enclosed for the statutory fees.

Respectfully submitted,

BY:



HARRIET E. PERKINS, ESQ.

MICHAEL F. SNYDER, ESQ.

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Fax: 215-988-2757

Attorneys for Petitioner



IKON Office Solutions West, Inc.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on the date indicated below.

BY

DATE

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 01/21/2002 15:12:51 ET

Serial Number: 76287234

Registration Number: (NOT AVAILABLE)

Mark (words only): IOS CAPITAL

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2001-09-05

Filing Date: 2001-07-18

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 105

CURRENT APPLICANT(S)/OWNER(S)

1. IKON Office Solutions West, Inc.

Address:

IKON Office Solutions West, Inc.
1210 SW Garden Place
Portland, OR 97223
United States

Country of Citizenship: United States

Incorporated in State: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

financing services

International Class: 036

First Use Date: 19980222

First Use in Commerce Date: 19980222

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-09-05 - Non-final action mailed

2001-09-04 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Harriet E. Perkins (Attorney of record)

HARRIET E. PERKINS
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PHILADELPHIA PA 19103-6996
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 01/21/2002 15:12:28 ET

Serial Number: 75870876

Registration Number: 2454883

Mark (words only): IOS

Current Status: Registered.

Date of Status: 2001-05-29

Filing Date: 1999-12-13

Registration Date: 2001-05-29

Law Office Assigned: TMO Law Office 113

CURRENT APPLICANT(S)/OWNER(S)

1. Integrity Office Solutions, L.L.C.

Address:

Integrity Office Solutions, L.L.C.
200 Lexington Avenue, Suite 1616
New York, NY 10016
United States

Country of Citizenship: United States

Incorporated in State: New Jersey

Legal Entity Type: Other

GOODS AND/OR SERVICES

PROVIDING A SINGLE SOURCE TURNKEY OUTSOURCING SOLUTION FOR COMPANIES THAT ARE UPGRADING, EXPANDING OR MOVING IN THE NATURE OF PROCUREMENT SERVICES, NAMELY, PURCHASING OR LEASING OFFICE EQUIPMENT AND FURNITURE FOR OTHERS

International Class: 035

First Use Date: 19990500

First Use in Commerce Date: 19990500

Basis: 1(a)

PROVIDING A SINGLE SOURCE TURNKEY OUTSOURCING SOLUTION FOR COMPANIES THAT ARE UPGRADING, EXPANDING OR MOVING, BY PROVIDING LEASE FINANCING

International Class: 036

First Use Date: 19990500

First Use in Commerce Date: 19990500

Basis: 1(a)

PROVIDING A SINGLE SOURCE TURNKEY OUTSOURCING SOLUTION FOR COMPANIES THAT ARE UPGRADING, EXPANDING OR MOVING IN THE NATURE OF INSTALLING OF OFFICE FURNITURE AND FLOORING, AND PLANNING, LAYING OUT AND CONSTRUCTING OF COMMERCIAL OFFICE SPACE FOR OTHERS

International Class: 037

First Use Date: 19990500

First Use in Commerce Date: 19990500

Basis: 1(a)

PROVIDING A SINGLE SOURCE TURNKEY OUTSOURCING SOLUTION FOR COMPANIES, NAMELY, DESIGNING FOR OTHERS AN INTEGRATED PACKAGE OF OFFICE EQUIPMENT, FURNITURE AND OFFICE LAYOUT PLANNING, INCLUDING COMPREHENSIVE PROJECT MANAGEMENT AND TECHNOLOGY DESIGN AND TRANSFER, FOR USE IN ASSISTING BUSINESSES TO UPGRADE, EXPAND AND RELOCATE

International Class: 042

First Use Date: 19990500

First Use in Commerce Date: 19990500

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-05-29 - Registered - Principal Register

2001-03-06 - Published for opposition

2001-02-21 - Notice of publication

2000-12-18 - Approved for Pub - Principal Register (Initial exam)

2000-11-21 - Communication received from applicant

2000-10-19 - Case file assigned to examining attorney

2000-09-20 - Communication received from applicant

2000-05-05 - Non-final action mailed

2000-05-04 - Case file assigned to examining attorney

2000-04-28 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

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